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EXAMINER

HARMON, CHRISTOPHER R

ART UNIT PAPER NUMBER

3721

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/559,704

Filing Date: 4/27/00

Appellant(s): Zoeckler

**MAILED**

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**GROUP 3700**

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Keats Quinalty

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 2/02/05 appealing from the Office action mailed 8/25/04.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/971,469

09/818,023

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is present however is not fully agreed with ie. persuasive arguments/statements contained therein.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Stone	(US 5,551,938)	9-1996.
Stokes	(US 1,880,288)	10-1932.
Lang	(US 5,147,480)	9-1992.
Campbell et al.	(US 1,600,396)	9-1926.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 11-16, 25-29, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone (US 5,551,938).

Stone discloses a method for forming carton blanks comprising advancing a web of paperboard 42 along a path; progressively applying, with an adhesive, at least one ribbon of reinforcing material 38 with a width less than the paperboard substantially overlying a selected panel portion (56); the paperboard is then cut into individual carton blanks and then are formed into cartons for receiving articles (see figures 1-3). Stone teaches manufacturing a paperboard carton with a reinforcing collar made of "either paperboard, thick paper...or flexible plastic." (column 4, lines 48-49). Therefore paperboard trim, cull, etc. is considered anticipated by Stone.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7, 9-11, 16, 25, 29-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang (US 5,147,480) in view of Campbell et al. (US 1,600,396).

Lang discloses a method of making paperboard cartons comprising advancing a web of paperboard 48 to a laminator/reinforcer which applies at least one layer of

material to the paperboard; see figures 3 and 4. The web is then cut/scored and then formed into cartons. Lang discloses printing on the reinforcing layers.

Lang does not disclose the use of laminating non-corrugated material, however Campbell teaches reinforcing non-corrugated paperboard as well as corrugated paperboard; see column 1 lines 1-5 and 37-44. It would have been obvious to a person of ordinary skill in the art to use the method of Lang on non-corrugated paperboard as described by Campbell.

Claims 4-7 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US 5,551,938) in view of Stokes (US 1,880,288).

Stone does not disclose a plurality of reinforcing ribbons, however Stokes teaches reinforcing carton blanks with ribbons (t); see figures 1-1a. It would have been obvious to one of ordinary skill in the art to use the teachings of Stokes in the invention to Stone in order to reinforce more than one side of the carton for greater strength.

#### **(10) Response to Argument**

Applicant's arguments filed 2/2/05 have been fully considered but they are not persuasive.

##### **A) Regarding the 102(b) rejection anticipated by Stone '938:**

Stone discloses reinforcing substantially all of panel portion 56 by adhering the strip 38 (see figures 2 and 3). Stone discloses "only one or more of the panels 56, 58, and 60 are bonded to the carton blank 44." (column 6, lines 54-55). Thus the adhesive

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application of reinforcing ribbon/strip 38 overlying "substantially all" of this panel portion is fully anticipated.

The language "substantially all of a selected panel portion of the web" is extremely broad. Note: During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 904.1. Therefore any portion of any panel that is adhered to and covered by another (reinforcing) layer could be reasonably selected.

Furthermore, Stone specifically discloses modifying the width of the reinforcing collar 24 (also reinforcing strip 38) providing "the collar 24 may be modified so that the collar is relatively narrow... or relatively wide" column 6, lines 43-44. Widening of the strip 38 would anticipate appellant's narrow interpretation of this limitation ie. the smallest "selected panel portion" 50 would be substantially covered and adhered to by reinforcing material 38; see figure 3.

In addition, Stone recognizes the capability of using a "full height liner", however does not explicitly teach an embodiment (which would presumably adhere to and cover all of every panel portion) in order to save material; see column 2, lines 25-27.

B) Regarding the 103(a) rejection over Stone '938 and Stokes '288:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Stone '938 is concerned with strengthening panel portions of a container and creating a lid, which can be securely opened and closed repeatedly (see column 1, lines 16-19). Stone accomplishes this by press bonding multiple laminates together; see figure 2). Stokes is also concerned with reinforcing containers and also uses a laminating technique. Laminating with multiple laminates is well established and generally available as is specifically taught by Stokes. If a container thus required further strengthening or reinforcement, one of ordinary skill in the art could easily conclude to apply multiple laminates.

C) Regarding the 103(a) rejection over Lang '480,

Appellant's is arguing the limitation of "non-corrugated paperboard" as an essential limitation to the claimed invention. This is not persuasive. The limitation claiming "non-corrugated paperboard" in order to exclude other forms of paperboard (ie. corrugated) was in response to overcome a final rejection filed with a Request for Reconsideration 3/15/04. Nothing in the summary of the invention (specification pages 8-12) details the essential nature of the paperboard used in the method to be non-corrugated. The specification briefly discusses the problems with construction using micro-fluted paperboard (pages 4-8) however, nothing in the detailed description of the specification pages 13-17 differentiates paperboard web 17 as being "non-corrugated".

In contrast appellant, in describing paperboard reinforcing ribbons, states in page 17, lines 7-11 of the specification "It should be understood, however, that the term "paperboard" when used in this context is intended to encompass and include any material with the physical and mechanical attributes necessary to provide the requisite reinforcing properties."

Appellant has set a broad enough foundation for claiming "non-corrugated" paperboard, thereby excluding "corrugated" paperboard, however also sets forth a broad range of alternatives capable of being interpreted as "paperboard". Such a depiction does not coincide with the argument that a "non-corrugated" paperboard material cannot be easily substituted with an alternative nor would one of ordinary skill in the art fail to be capable of ascertaining such a substitution.

Further note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One having ordinary skill could easily determine physical differences between variations of paperboard eg. strength, pliability, etc.

Paperboard is well known to comprise many alternatives (as indicated by appellant in the specification) including but not limited to corrugated and non-corrugated types:

**pa·per·board** (pâ'per-bôrd', -bord') *noun*



Cardboard; pasteboard.<sup>1</sup>

Appellant's application of *In re Ahlert* is misguided and not relevant. The use of either a corrugated paperboard material or a non-corrugated paperboard material in the manufacture of containers is not a technical fact in an area of esoteric technology or specific knowledge of the prior art.

The correct test is whether the common knowledge "is capable of instant and unquestionable demonstration as being well known." See *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). In view of this *Campbell et al.* (US 1,600,396) teaches corrugated paperboard and non-corrugated paperboard as well known alternatives for manufacturing containers in the art (see above) as well as many other cited references in the prosecution history ie. Anderson '117, Confer '538, Smith '702.

D) Regarding appellant's affidavit filed 3/15/04,

The affidavit was considered at the time of the previous submission and was not persuasive as a secondary consideration. Objective evidence of commercial success does not include predicted commercial success. Evidence of actual success ie. substantial increase in profits directly linked to a new improved product may evidence commercial success.


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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

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